

Customer No.: 31561
Docket No.: 10721-US-PA
Application No.: 10/711,280

REMARKS

This is a full and timely response to the outstanding non-final Office action electronically delivered on July 12, 2007. Reconsideration and allowance of the application and presently pending claims 1-8 are respectfully requested.

Present Status of Application

It has been acknowledged that the Examiner has raised a new ground of rejection in view of the previous amendment filed on May 4, 2007.

According to the outstanding Office action, claims 1 and 6 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Lin et al. (USPAP 2002/0105076; "Lin" hereinafter) in view of Su et al. (USPAP 2007/0028445 A1; "Su" hereinafter). Claims 3 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lin in view of Su and further in view of Lee (USPAP 2002/0104449, "Lee'449" hereinafter). Claims 5 and 7-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lin in view of Su and further in view of Lee et al. (USPAP 2003/0134496; "Lee'496" hereinafter).

Responsive thereto, Applicants respectfully submit claims 1-8 are in proper condition for allowance by virtue of at least the reasons furnished hereinafter, and reconsideration of this application is courteously requested.

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Discussion for 35 U.S.C. §103 rejections

Claims 1 and 6 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Lin in view of Su. Claims 3 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lin in view of Su and further in view of Lee '449. Claims 5 and 7-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lin in view of Su and further in view of Lee '496. Applicants respectfully controvert the obviousness rejection for at least a prima facie case of obviousness has not yet been established by this Office action.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be **some suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See MPEP § 2143.

Moreover, "in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must **either be in the field of applicant's endeavor** or, if not, then be reasonably **pertinent to the particular problem with which the inventor was concerned**." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)." As described in the responses to the 3rd and 4th Office Actions to the present

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application, Applicant respectively submit that the Office Action does not provide a reasonable grounds or rationale about how Lin's teachings lead to equivalence or similarity as the step "providing a wafer having a plurality of LED chips thereon." Lin discloses a method of removing damage to I/O pads that have been contacted by test probes (see Field of Invention). The Office action asserted device elements (such as, diodes) recited by Lin (paragraph [0004]) as comparable to the LED chips of this application. According to Lin's context (paragraph [0004]) reciting "The creation of monolithic integrated circuits requires the creation of numerous interacting electrical device elements, which are typically created in or on the surface of a semiconductor substrate. Among these device elements are transistors, diodes, bipolar transistors, CMOS Field Effect Transistors of either N or P channel type and the like.", it is clear to any sensible person that this statement merely describes various device elements in the semiconductor manufacturing industry. Further, nothing is mentioned anywhere in Lin's paper that the substrate 10 includes anything other than the aluminum contact pad 24. Nevertheless, the field of invention of the subject application is directed to a bumping process for a flip chip package structure of an LED, so as to reduce the cycle time and costs, to accurately control the height and the composition of bumps for improving the reliability of the LED chip package structures, and to diversify the choices for the bump materials because the composition of the bumps can be adjusted by choosing solder materials (paste) of variable compositions. Therefore, it is respectfully submitted that the cited reference Lin is neither within the field of applicant's endeavor nor reasonably

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pertinent to the particular problem with which the inventor was concerned, and that the cited reference should not be considered as an appropriate analogous art.

In light of the foregoing, the Office action does not provide reasonable ground or rationale about how Lin's teachings lead to equivalence or similarity as recited in claim 1 of the present invention. Owing to Lin's failure to disclose each and every feature as claimed in the present invention, it is submitted that Lin, Su, or any other cited references of record, taken alone or in combination, does not teach or suggest all the claim limitations in Applicants' claim 1. It is thus believed that the *prima facie* case of obviousness has not yet been established, and Applicants' claim 1 should be non-obvious and allowable. Furthermore, the reference Lin is not qualified as a proper analogous art over the present invention, and thus the 103 rejections of claim 1 and claims 2-8 based on the cited reference Lin, Su, Lee'449 and Lee'496 should be withdrawn. Reconsideration of the subject application is accordingly solicited in all sincerity.

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CONCLUSION

In view of the foregoing reasons, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

Date :

Respectfully submitted,

Oct. 12, 2007

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